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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,387	04/19/2000	MARC DANIEL	A32851-PCTU	5025

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/14/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/462,387

Applicant(s)

DANIEL ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 13 and 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jalics et al. (U.S. 5,708,053).

The rejection is adequately set forth in paragraph 3 of the office action mailed 6/26/01, Paper No.10, and is incorporated here by reference.

3. Claims 13, 15-22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hojo (U.S. 5,939,493) in view of Jalics et al. (U.S. 5, 708,053).

The rejection is adequately set forth in paragraph 4 of the office action mailed 6/26/01, Paper No.10, and is incorporated here by reference.

4. Claims 13, 15-22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakafutami et al. (U.S. 5,804,644) or Halasa et al. (U.S. 5,534,592) either of which in view of either Hojo (U.S. 5,939,493) or Araki et al. (U.S. 5,939,484).

The rejection is adequately set forth in paragraph 5 of the office action mailed 6/26/01, Paper No.10, and is incorporated here by reference.

5. Claims 13, 15-21 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bomal et al. (U.S. 6,140,393) in view of either Hojo (U.S. 5,939,493) or Araki et al. (U.S. 5,939,484).

The rejection is adequately set forth in paragraph 6 of the office action mailed 6/26/01, Paper No.10, and is incorporated here by reference.

Response to Arguments

6. Applicants' arguments filed 2/26/01 have been fully considered but they are not persuasive.

Specifically, applicants argue that:

(a) There is no disclosure in Jalics et al. that the rubber composition has improved hysteresis loss and reinforcement, which is the objective of the present invention.

(b) There is no disclosure in Jalics et al. of the combination of amine and guanidine as required in the present claims.

(c) There is no disclosure in Hojo et al. or Nakafutami et al. of rubber composition with improved hysteresis loss and reinforcement, which is the objective of the present invention.

(d) Hojo requires the use of metal dithiophosphate vulcanization accelerator not amine as presently claimed.

(e) There is no motivation to combine Hojo with Jalics et al. given that Hojo is drawn to carbon black-filled composition while Jalics et al. is drawn to silica-filled rubber composition.

(f) Example 4 of the present specification establishes unexpected or surprising results over Hojo in view of Jalics et al.

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(g) There is no disclosure in Nakafutami et al., Halasa et al., or Bomal et al. of amine and no motivation to combine any of these references with Hojo.

(h) There is no motivation to combine Nakafutami et al., Halasa et al., or Bomal et al. with Araki et al. given that Nakafutami et al., Halasa et al., or Bomal et al. each solve different problems than Araki et al.

(i) Example 4 establishes unexpected or surprising results over Nakafutami et al., Halasa et al., or Bomal et al. in view of Hojo or Araki et al.

With respect to argument (a), it is noted that the present claims are drawn to a rubber composition comprising polymer, silica, promoting agent, guanidine, and free amine. Given that Jalics et al. disclose such a composition, it is the examiner's position that Jalics et al. meets the limitations of the present claims. There is no requirement in the claims regarding hysteresis loss or reinforcement properties. Further, if such limitations were present, given that Jalics et al. disclose composition as presently claimed, it would have been natural for one of ordinary skill in the art to infer that the composition intrinsically possesses hysteresis loss and reinforcement properties as presently claimed.

With respect to argument (b), applicants argue that Jalics et al. preferably utilize a combination of sulfenamide and guanidine not amine and guanidine as presently claimed. Applicants further point to example 4 of the present specification and state that this example shows the criticality of using combination of amine and guanidine as presently claimed.

However, with respect to Jalics et al. is noted that Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of Jalics et al. as a whole discloses that amine is an accelerator utilized by Jalics et al. (col.9, line 12).

With respect to the comparative data in example 4, it is the noted that a composition within the scope of the present claims, i.e. comprising amine and guanidine (composition 19) is compared with a composition outside the scope of the present claims, i.e. comprising guanidine but no amine (compositions 16 and 18) or amine but no guanidine (composition 17). However, it is the examiner’s position that this data does not establish unexpected or surprising results over the closest prior art, namely, Jalics et al., given that Jalics et al. already discloses the use of both amine and guanidine.

If applicants were to submit comparative data comparing composition within the scope of the present claims, i.e. comprising amine and guanidine, with composition outside the scope of the present claims but within the scope of Jalics et al., i.e. composition comprising sulfenamide and guanidine, examiner would be willing to consider such data.

With respect to argument (c), it is noted that the present claims are drawn to a rubber composition comprising polymer, silica, promoting agent, guanidine, and free amine. Given that Hojo or Nakafutami et al., in combination with other references, disclose such a composition, it

is the examiner's position that these combinations of references meet the limitations of the present claims. There is no requirement in the claims regarding hysteresis loss or reinforcement properties. Further, if such limitations were present, given that Hojo or Nakafutami et al., in combination with other references, disclose composition as presently claimed, it would have been natural for one of ordinary skill in the art to infer that the composition intrinsically possesses hysteresis loss and reinforcement properties as presently claimed.

With respect to argument (d), while Hojo does require the use of metal dithiophosphate, col.9, lines 29-31 disclose the use of amine in addition to the metal dithiophosphate.

With respect to argument (e), it is noted that col.8, lines 21-22 and 26-27 of Hojo disclose that silica is the preferred filler not carbon black.

With respect to argument (f), it is the examiner's position that the data as set forth in example 4 of the present specification does not successfully establish unexpected or surprising results over the cited prior art given that data does not show proper side-by-side comparison between composition of the present invention, i.e. comprising amine and guanidine (see composition 19), and composition outside the scope of the present claims, i.e. comprising amine not guanidine (composition 17) given that composition 19 and composition 17 utilize different amounts of amine. That is, given that composition 19 uses 1.2 parts amine while composition 17 uses 1.9 parts amine, the examiner cannot tell if the differences between the compositions are due to the presence of guanidine or to the difference in the amount of amine.

With respect to argument (g), applicants argue that there is no motivation to combine Nakafutami et al., Halasa et al., or Bomal et al. with Hojo given that Hojo is a carbon black-filled composition and requires the use of specific vulcanization accelerator.

As noted with respect to argument (c) above, it is the examiner's position that Hojo does in fact disclose a silica-filled composition as presently claimed.

Further, with respect to the metal dithiophosphate disclosed in Hojo, it is noted that it is not necessary that the inventions of the references be physically combinable to render obvious the invention under review, *In re Sneed*, 710 F.2d 1544, 218 USPQ 385, 389 (Fed. Cir. 1983) and that combining the teachings of references does not involve an ability to combine their specific structures, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973).

Hojo teaches using amine as presently claimed when silica is used as the filler (col.9, lines 29-31) in order to improve resistance to heat aging and abrasion resistance. Given that Nakafutami et al., Halasa et al., and Bomal et al. each disclose composition which utilizes silica, it is the examiner's position that there is proper motivation to combine the references.

With respect to argument (h), applicants are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an applicants' invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Araki et al.

is a reasonable pertinent reference because even though it solves a different problem than those solved in either Nakafutami et al., Halasa et al., or Bomal et al., Araki et al. is drawn to the same field of endeavor as these references, i.e. rubber composition for tires, and disclose that the use of amine in order to improve the dispersion of silica which is a function especially important to each of Nakafutami et al., Halasa et al., and Bomal et al. which all disclose rubber compositions containing silica. Further, regardless of the problem to be solved, the amine will function in the rubber composition of either Nakafutami et al., Halasa et al., or Bomal et al. the same as it functions in Araki et al.

With respect to argument (i), applicants argue that example 4 establishes unexpected or surprising results over Nakafutami et al., Halasa et al., or Bomal et al. in view of Hojo or Araki et al.. It is noted that in example 4 a composition within the scope of the present claims, i.e. comprising amine and guanidine (composition 19), is compared with a composition outside the scope of the present claims, i.e. comprising guanidine but no amine (compositions 16 and 18). It is the examiner's position that this data does not establish unexpected or surprising results over the cited prior art given that composition 18 which is outside the scope of the present claims but within the scope of Nakafutami et al., Halasa et al., or Bomal et al. exhibits better hysteresis loss than composition 16 which is a composition of the present invention.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie Shosho
March 12, 2002

Vasu Jagannathan
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SUPERVISORY PATENT EXAMINER
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